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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/928,110      | 08/10/2001  | Victoria F. Dole     | JBP-563             | 6271             |

27777 7590 07/01/2003  
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| EXAMINER |
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YU, GINA C

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| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/928,110

Applicant(s)

DOLE ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 14, 2003 has been entered. Claims 1-13 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 9, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "derivatives" recited in claim 8, lines 4 and 5 and claim 9, lines 10 and 12 renders the claims vague and indefinite. The term "derivatives" is not defined by applicants' disclosure, and the metes and bounds of the scope of the claims are unclear.

The term "protecting" in claim 13, line 1 renders the claim vague and indefinite, as the metes and bounds of the scope of the claim are unclear.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Menda et al. (US 4000317) ("Menda").

Menda discloses a composition comprising 2.0 % wt of pyrogenic colloidal silica, 48.2 % wt of water, 0.0008 % wt of FD & D Blue dye #1. See Example 3; instant claims 1-3, 10, and 11. The recitation "for forming a cosmetic mask" is viewed a preamble stating an intended use or purpose and not a structural limitation.

Since all the limitations to the composition are met, examiner views that the color-changing property of the prior art composition is also met since such a color change is an inherent property of the composition.

2. Claims 1-4, 8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Strianse et al. (US 4362715) ("Strianse").

Strianse discloses a silica gel comprising 2-25 % of zeolite of alumino-silicate in water base gel. See Example 1. The reference teaches an anti-acne cream composition comprising the 40 parts by weight (pbw) of silica gel, 0.8 pbw of colorants, 1.0 pbw of hydrophobic silica, propylene glycol, and water to balance to 100 pbw. See Example 11; instant claims 1-4, 8, and 11.

The recitation "for forming a cosmetic mask" is viewed a preamble stating an intended use or purpose and not a structural limitation.

Since all the limitations to the composition are met, examiner views that the color-changing property of the prior art composition is also met since such a color change is an inherent property of the composition.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neova product label in view of Gerstein (US 5139771).

Neova product label discloses silica-containing skin mask composition. The composition comprises water, silica, glycerin, polysorbate 20, and preservatives. Neova product label also discloses that silica in the composition absorbs excess oils while glycerin provides moisture to the skin. The composition is said to cleanse and provide skin fresh feel. See instant claims 12 and 13. The method of using the composition is also disclosed. See Directions; instant claim 11.

Neova fails to teach using colorant or the quantity of surfactants used.

Gerstein teaches skin-cleansing mask compositions. See abstract. The reference teaches to add colorants to "impart a pleasant color" to the composition. See col. 5, lines 27 – 33; instant claim 1. Example 5 employs FD & C green # 5, and all of the FD&C colors approved for cosmetic use and inorganic pigments are said to be suitable for the invention. While Gerstein does not disclose the recited colorants in instant claim 10, examiner takes the position that, in view of the general teaching in the reference, the difference in color is a mere preference of a skilled artisan and not a nonobvious selection over the prior art. See also Examples 4, 8, and 9 for the use of various colorants.

Gerstein further teaches that 0.1-7 % of surfactants, such as polysorbate 20, can be added in the compositions. See col. 4, line 52 – col. 5, line 14; col. 5, lines 43 – 64; see instant claims 5 and 6. Humectants such as glycerin (or glycerol) and moisturizer can be used up to 1.0 % and 3.0 %, respectively. See col. 4, lines 38 – 51; col. 5, lines 33 – 43; see instant claims 7-9. Using glycerin, propylene glycol, polyethylene glycol, and ethoxylated lanolin alcohols up to 2.0 % as plasticizer is also suggested. See col. 5, lines 17 – 21.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Neova mask composition by adding colorants, as motivated by Gerstein, because of the expectation of successfully producing a colored mask composition. The claimed invention is a composition with a particular characteristic. While the combined references do not explicitly provide that the color

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change occurs as the composition dries, examiner takes the position that the same composition as recited in the instant claims would obviously have same color changing property upon drying, absent evidence indicating to the contrary.

All components in the instant claims are known. Nothing nonobvious or unexpected is seen in combining conventional ingredients well known in cosmetic art. See MPEP § 718.02.

2. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neova product label and Gerstein as applied to claims 1-10, 12, and 13 above, and further in view of Cabot Technical Data.

While Neova product label, discussed above, teaches that silica is effective in absorbing excess oil, as discussed above, the reference fails to disclose the type of silica used in the composition.

Cabot Technical Data teaches fumed silica useful in wide range of cosmetic products. The reference teaches that the fumed silica adsorbs excess oil on the skin. See p. 5, Powders.

It would have been obvious to a skilled artisan at the time the invention was made to have looked to the prior art such as Carbot Technical Data for a specific type of silica, and used the disclosed fumed silica therein in formulating the skin-cleansing mask composition of the combined references, Neova product label and Gerstein, because of the expectation of successfully producing a skin-cleansing mask that would be effective in removing excess oil.

3. Claims 1-4 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jung (US 5139782).

Jung teaches facial cleansing mineral composition comprising silica zeolite (silica molecular sieve). See abstract. The reference teaches that "colorants may be aesthetically desirable", while absence of colorants is acceptable as well. Jung further teaches to add polyols such as propylene glycol and sorbitol for conditioning the skin. See col. 4, lines 28 – 39.

While the reference does not explicitly provide that the color changes as the composition dries, examiner notes that the color change is an obvious property of the prior art composition which otherwise meets the limitation of the instant claims, absent evidence indicating to the contrary.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

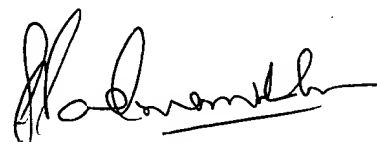


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308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
June 27, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER

6/27/03